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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,763	10/17/2001	William Sanford	00725.0361-US-01	8838
22865	7590	05/04/2009		
Altera Law Group, LLC 220 S 6 St Suite 1700 Minneapolis, MN 55402			EXAMINER CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1794	
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			05/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/981,763

Applicant(s)

SANFORD, WILLIAM

Examiner

VICTOR S. CHANG

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. Applicant's remarks filed on 3/3/2009 have been entered. Claims 32-44 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 102

4. Claims 32-38 and 40-44 are rejected under 35 U.S.C. 102(a) because the applicant did not invent the claimed subject matter, as evidenced by MacWilliams et al. [EP 1 129 866].

MacWilliams' invention relates to an alignable label system 100 comprising a label sheet 130 having a central split line 111, the label sheet having a perimeter line separating a label 101 from a second portion (outside the perimeter). The system further comprises a backing member 102 applied to the label and having a split line 111. An alignment section on the second portion is separable from the label and includes an edge to conform to the edge of a folder [abstract].

For claim 32, regarding the use language "wherein when one portion ...affixed to the folder", since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight.

For claim 33, Fig. 2 illustrates that the curved edge 116a is proximate at least one edge of the label.

For claim 34, MacWilliams teaches a method of aligning and applying a label to the edge of a folder comprising the steps of removing a portion of the backing member from the label, aligning the alignment section to the edge of the folder, applying the label, peeling of the remaining backing member and folding the label over the edge [0028-0030].

For claim 35, the top side of the label is adapted for printing.

For claims 36-37, Figs. 1 and 2 illustrates that the curved edge is “S”-shaped.

For claims 38 and 44, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight.

For claim 40, the label is adhesive [0019] on the surface contacting the backing member.

For claim 41, Fig. 1 shows a plurality of labels 110, 112, 113 with die-cut lines therebetween.

For claim 42, the die-cuts 116a and 117 separate the second portion into first and second parts, and wherein the label split lines and at least in part, follows a curve which is substantially the same the folder's curved edge as shown by line 116a in Fig. 1.

For claim 43, MacWilliams teaches the step of removing the backing sheet along the split line [0028].

5. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacWilliams et al. [EP 1 129 866].

MacWilliams lacks a teaching that the curved portion on the second portion is spaced from the label. However, MacWilliams illustrates in Fig. 1 that a curved portion 116a is perforated and would have tie portions between the cut portions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to space the label from the

curved portion, and the tie portions would provide for the spacing of the curved portion from the label.

Response to Arguments

6. Applicant's arguments at Remarks page 6:

"EP 1129866 cannot be applied as a reference because of a Rule 1.136 affidavit of the inventor already on file in this case (filed 18 June 2007- in fact it was also submitted twice, once in 2006). This 131 affidavit was accepted to remove another reference of record, but stands against all references to be considered against these claims. This affidavit of record, makes the publication date of EP reference (September 5, 2001) well after the conception date of at least as early as 24 October 2000. This means that, with the 131 affidavit on file the EP reference should not have been asserted as prior art. The failure to notice this 131 affidavit was no doubt an oversight by the examiner as this is a lengthy file history."

However, a review shows that while an affidavit or declaration under 1.131 is sufficient to overcome 102(e) based rejection, it is insufficient to overcome a rejection under 102 (a) over a foreign reference. Moreover, the swear back affidavit or declaration is applicable to US Patent or US patent application publication, it is insufficient to overcome a foreign publication, even if the affidavit or declaration is filed under 1.130. MPEP 2146.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794